

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

MAIL STOP PCT

Naoto NAKAMURA et al.

Application No.: 10/528,069

Filed: March 15, 2005

Docket No.: 122733

For: THERMAL TREATMENT APPARATUS, METHOD FOR MANUFACTURING
SEMICONDUCTOR DEVICE, AND METHOD FOR MANUFACTURING
SUBSTRATE

RESPONSE TO DECISION ON PETITION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The attached September 13, 2006 Decision on Petition ("Decision") indicates (page 2) that Applicants' Petition Under 37 C.F.R. §1.47(a) is rendered moot because Applicants provided a Declaration executed by all the inventors.

The Decision, however, further indicates that the Declaration of the inventors filed on July 10, 2006 is considered non-compliant with 37 C.F.R. §1.69(b). The Decision asserts Applicants have not used one of the pre-approved foreign language forms nor have Applicants furnished the requisite statement attesting to the accuracy of the translation.

Applicants respectfully submit that the July 10, 2006 Declaration (copy attached) is in compliance with the rules. Rule 69(b) applies to Declarations "in a language other than English." The fact that the Declaration executed by the inventors, which is in English, also includes a Japanese Declaration does not make this document a non-English-language Declaration. It is, therefore, not a Declaration that requires any further consideration under 37

C.F.R. §1.69(b). Each of the inventors executed this English and Japanese-language Declaration. There is no reason to believe, nor assume, that the inventors did not understand the English-language Declaration when they executed it.

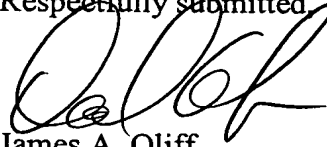
Rule 69(b) is directed to a Declaration of the inventors that is wholly in a foreign language and executed that way. Such a document would, under the Rule, if not of a form approved by the Patent Office, require a separate translation. It is understood that such a translation would not be executed by the inventors, but rather simply state what the executed document says, with a separate statement attesting that the translation is accurate.

In this case, Applicants submitted a Declaration that is not in a language other than English. Rather, Applicants executed and submitted an English-language Declaration. As such, the July 10 Declaration is proper, and in compliance with the Rules, because the form of this Declaration does not impute any requirement for further documentation under 37 C.F.R. §1.69(b).

Alternatively, should the above explanation be, in any way, considered non-responsive, Applicants respectfully submit that the English-language version of the Declaration is an accurate translation of the Japanese version.

Should any questions arise regarding this correspondence, all inquiries may be directed to Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Daniel A. Tanner, III
Registration No. 54,734

JAO:DAT/cfr

Attachment:

U.S. PTO Decision on Petition dated September 13, 2006

Copy of the Declaration Executed by the Inventors Submitted July 10, 2006

Date: September 27, 2006

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

**DEPOSIT ACCOUNT USE
AUTHORIZATION**

Please grant any extension
necessary for entry;

Charge any fee due to our
Deposit Account No. 15-0461

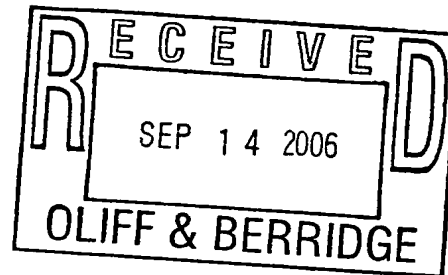


UNITED STATES PATENT AND TRADEMARK OFFICE

OAT

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

13 SEP 2006



OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA VA 22320

In re Application of
NAKAMURA et al.
Application No.: 10/528,069
PCT No.: PCT/JP03/12353
Int. Filing Date: 26 September 2003
Priority Date: 27 September 2002
Attorney Docket No.: 122733
For: THERMAL TREATMENT APPARATUS,
METHOD FOR MANUFACTURING
SEMICONDUCTOR DEVICE, AND METHOD
FOR MANUFACTURING SUBSTRATE

DECISION

This decision is in response to the submission filed 10 July 2006 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 26 September 2003, applicants filed international application PCT/JP03/12353, which designated the United States and claimed a priority date of 27 September 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 08 April 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 28 March 2005 (27 March 2005 being a Sunday).

On 15 March 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a translation of the application into English.

On 26 August 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required.

On 07 October 2005, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration of inventors, a declaration of facts by Mr. Akihiro Fukushima, a copy of a letter sent to non-signing inventor Mr. Shimada on April 6, 2005 and an

English translation thereof, a copy of a letter sent to Mr. Shimada on May 23, 2005 and an English translation thereof, and copies of two certified mail receipts and English translations thereof.

On 03 March 2006, a decision was mailed dismissing applicants' petition under 37 CFR 1.47(a). However, that decision failed to take into account the declaration of facts by Mr. Akihiro Fukushima.

On 13 March 2006, a supplemental decision was mailed vacating the decision mailed 03 March 2006 and taking into account the declaration of facts by Mr. Akihiro Fukushima. The decision dismissed applicants' petition under 37 CFR 1.47(a) without prejudice because applicant had failed to provide factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort. The decision also indicated that a translation of the Figures was required.

On 10 July 2006, applicants filed the instant submission which was accompanied by, *inter alia*, a declaration of inventors and a translation of the Figures.

DISCUSSION

Since a 37 CFR 1.497 declaration has been executed by all the joint inventors, the petition for status under 37 CFR 1.47(a) is moot. The application need not be returned to the Office of PCT Legal Affairs for any further consideration of the status under 37 CFR 1.47 and no such status should be indicated on this application file.

The declaration of inventors filed 10 July 2006 is not in compliance with 37 CFR 1.69(b), specifically applicants have not used one of the pre-approved foreign language forms nor have applicants furnished the requisite statement attesting to the accuracy of the translation.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** as **MOOT**.

Since the reply filed 10 July 2006 appears to have been bona fide, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to provide (1) a pre-approved foreign language declaration in compliance with 37 CFR 1.497(a)-(b) or (2) the requisite statement under 37 CFR 1.69(b) that the translation is accurate. Failure to timely file a proper reply will result in abandonment of the application.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria,

Application No.: 10/528,069

-3-

Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Daniel Stemmer

Legal Examiner

PCT Legal Affairs

Office of Patent Cooperation Treaty

Legal Administration

Telephone: (571) 272-3301

Facsimile: (571) 273-0459